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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,729	12/21/2001	Jaap M. Middeldorp	9250-13DVCTDV	6359

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MYERS BIGEL SIBLEY & SAJOVEC  
PO BOX 37428  
RALEIGH, NC 27627

EXAMINER

WOITACH, JOSEPH T

ART UNIT PAPER NUMBER

1632

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/036,729	MIDDELDORP ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joseph T. Voitach	1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 6-9, 26, 27 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7, 8, 26, 27 and 32-34 is/are allowed.
- 6) ☒ Claim(s) 6 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This application filed December 21, 2001, is a DIV of 09/205,169, filed 12/04/1998, now US Pat 6,365,717, which is a CON of 08/415,838, filed 04/03/1995, now US Pat 6,008,327, which is a DIV of 08/031,148, filed 03/12/1993, now US Pat 5,424,398.

Applicants' amendment filed June 7, 2006 has been received and entered. Claims 1-5, 10-25, 28-31 have been canceled. Claim 6 has been amended. Claims 6-9, 26, 27 and 32-34 are pending.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6 and 9 stand rejected under 35 U.S.C. 102(b) as being anticipated by Ambinder *et al.* (Abstracts from Annual Meeting American Society of Microbiology, 1989, 89 Meet., 111, cited previously).

Applicants note the amendments to claim 6, and summarize the basis of the rejection as it encompasses the embodiments of (b). Applicants argue that a reasonable interpretation of the claims as it is drawn to 6(a) would not be anticipated by the teaching of Ambinder *et al.* Applicants arguments have been fully considered, but not found persuasive.

In te previous office action, the Examiner set forth that a reasonable interpretation of claim 6(a) only sets forth VCA-p18/p40 and as a name would reasonable be interpreted to encompass all variants of these proteins that one in the art would term to be VCAp18/p40. Examiner would acknowledge that 6(b) more clearly sets forth variants, however given the guidance of the present specification the interpretation of VCAp18/p40 to encompass variants. Examiner agrees in part with Applicants interpretation in that claim 6(a) encompasses VCAp18/p40 of the specific sequence disclosed, however maintains that based on the guidance of the specification a reasonable interpretation would clearly encompasses variants. Moreover, it is noted again that there is no specific antibody set forth in the claims, nor defined in the specification that would limit the interpretation of the claim to any one particular sequence in VCAp18 and/or p40. In this case, absent evidence to the contrary, the nucleic acid disclosed by Ambinder *et al.*, which is different in sequences (thus a variant), would meet the limitations of the claims as broadly set forth.

According to *In re Best* 195 USPQ 430, 1997, the court stated that, "Patent Office can require applicant to prove that prior art products do not necessarily or inherently posses characteristics of his claimed product wherein claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicant" (pp. 430). The nucleic acid encoded by Ambinder *et al.* is structurally different (thus, a variant). Whether the protein encoded by the nucleic acid of Ambinder *et al.* is not determinable as the PTO does not have the facility to conduct experiments. It is determined that the burden has been shifted to Applicants to provide contradicting evidence.

Therefore, Ambinder *et al.* would anticipate the invention as claimed.

***Conclusion***

Claims 7, 8, 26, 27 and 32-34 are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

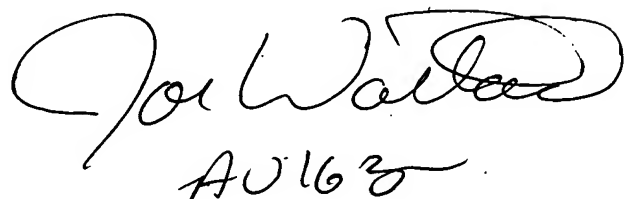
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached at (571) 272-0735.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571) 272-0532.

Joseph T. Woitach



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